

### REMARKS

Claims 1-9, 11, 12, 39-61 and 63-68 are pending. Claims 1, 6, 9, 45, 46, 48, 52, 57, 58 and 60 have been amended. Claims 2, 8, 10, 11, 13-38, 44, 47, 51 and 62 are cancelled. Claims 64-67 have been withdrawn from consideration. The amendments made herein are fully supported by the specification and the claims as originally filed. The nature of the claim amendments were designed to incorporate limitations from dependent claims previously presented. As such, the current amendments do not introduce new matter nor do they require the Office to conduct additional searching. Accordingly, entry of the present amendments and reconsideration of the present application is respectfully requested.

#### The pending claims are definite

Claims 1, 10 and 35-38 stand rejected under 35 USC 112, second paragraph for allegedly being indefinite for reciting the terms “noninterfering group,” “linker”, and “spacer”. Applicants respectfully disagree with the Office’s position that the use of these terms renders the pending claims indefinite. One of ordinary skill in the art would readily be able to discern the metes and bounds of the claimed invention in view of the language of the claims and the specification, taken as a whole. Nevertheless, to facilitate the prosecution of the present application, Applicants have made certain amendments to claim 1 that clarify the subject matter Applicants regard as their invention. The specific support for the amendments is discussed below.

In general, claim 1 has been amended to more particularly define what is meant by a “non-interfering substituent”. While Applicants maintain their position that this phrase is clearly defined in the specification, claim 1 has been amended as discussed below to clarify the subject regarded as the invention. Specifically, the term “Ar” in claim 1 has been amended to incorporate the limitations of dependent claim 47. The term “L<sup>2</sup>” in claim 1 has been amended to incorporate most of the limitations of dependent claim 44. Support for the amendment of term “L<sup>1</sup>” in claim 1 is found on page 7, line 22 to page 8, line 5. The term “R<sup>1</sup>” in claim 1 has been amended to incorporate the limitations of dependent claim 51. The terms “R<sup>2</sup>, R<sup>3</sup> and R<sup>4</sup>” have been amended to incorporate the limitations of claim 11. The term “R<sup>5</sup>” in claim 1 has been amended to incorporate the limitations of dependent claim 8. The term “R<sup>6</sup>” in claim 1 has been amended to incorporate the limitations of dependent claim 2.

The Office also alleged that the terms “heteroalkyl”, “heteroallylene”, heteroallylene”, and “heteroallynylene” recited in claims 44, 47, 52, 58 and 60 were indefinite and confusing. With the exception of the term “heteroalkyl”, the allegedly indefinite terms are not present in either the pending or amended claims set. Regarding the term “heteroalkyl”, claim 1 a large number of compounds illustrate this embodiment and the term is defined in the specification at page 7, lines 3-7. Additionally, the term “heteroforms” appearing in the various claims has been amended to specify the atoms that compose the so-called heteroforms.

These amendments obviate the grounds of rejection advanced in the final Office Action. As such, Applicants respectfully request that the present rejection of these claims be withdrawn.

The pending claims are fully supported by the specification

Claims 1, 3-9, 12-38, 40-63 and 68 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not supported in the specification. Applicants respectfully disagree.

The final Office Action explained that the Office considered the description of R2 and R3 being halogen, OR or alkyl lacks antecedent basis in the specification because Examples 1-6 are limited to chloro, fluoro, methoxy or acetylamino. Applicants note that literal support for the rejected claim language is provided in the specification, for example, in original claim 11 as filed. As such, the rejected claim language is clearly supported by the specification. Moreover, Applicants note that it is improper to limit the scope of the claims in view of the working examples, which are provided to be exemplary and not limiting.

In view of this disclosure, one of ordinary skill in the art would readily conclude that the inventors were in possession of the rejected subject matter at the time the application was filed. Thus, the rejected claims are fully supported by the specification and the present rejection should be withdrawn.

The pending claims are non-obvious

Claims 1, 3-9, 12, 40-61, 63 and 68 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ward *et al.* (U.S. Patent No. 5,166,136) in view of Rubini *et al.*, *Tetrahedron* 42:6039-6045 (1986). To support a *prima facie* case of obviousness, the Office must cite one or more references that, *inter alia*, teach or suggest all the limitations of the claimed

invention and provide a motivation to modify the cited reference or references to achieve the claimed invention. Applicants respectfully submit that the art cited by the Office in regards to the present rejection fails to teach the claimed invention and fails to provide the requisite motivation to modify the teachings of Ward *et al.* to achieve the claimed invention.

The Office has alleged that Ward *et al.* disclosed a compound that is useful in treating inflammation and that falls within the scope of the pending claims. The only difference, according to the Office, between the teachings of Ward *et al.* and the claimed invention lies in the presence of an oxo substitution in the spiran ring of the compound (Final Office Action, page 5). The Office cites Rubini *et al.*, which teaches modifying a pseudodipeptide to replace an amide linkage with a methylene-oxy linkage, as being advantageous. The Office reasoned that one of ordinary skill in the art would have been motivated to eliminate that oxo substitution in the spiran ring of the compound taught by Ward *et al.* using the teachings of Rubini *et al.* and thus achieving a compound that fell within the scope of the claimed invention. Applicants respectfully disagree because the nature of the compounds discussed by Rubini *et al.* differ so significantly from those of Ward *et al.* that the skilled artisan would not have been motivated to make the proposed modification. Moreover, even if a skilled artisan were so motivated, the proposed modification of Ward *et al.* would not result in the claimed invention.

Rubini *et al.* teach a modification of pseudodipeptides such that the carboxyl and nitrogen groups of an amide in a pseudodipeptide are replaced with a methylene-oxy group (Rubini *et al.*, page 6040). The compound taught by Ward *et al.* contains a spiran ring with an oxo group and it is upon this ring that a skilled artisan would have to apply the teachings of Rubini *et al.* to achieve the claimed invention. The Office, however, has provided no indication that Rubini *et al.* suggest that the modification of a pseudopeptide would be advantageous to the class of compounds taught by Ward *et al.* In view of this deficiency, Applicants submit that the Office has failed to articulate the requisite motivation to modify the cited references to achieve the claimed invention that is required to support an obviousness rejection.

Even if one of ordinary skill in the art were motivated to make the modification proposed by the Office, the resulting compound would not render the claimed invention obvious. The modification taught by Rubini *et al.* results in the removal of both the carboxyl group and the

nitrogen from the pseudodipeptide. An analogous modification would result in the removal of the a nitrogen atom from the spiran ring of the compound disclosed by Ward *et al.* Such a compound would fall outside of the metes and bounds of the pending claims. As such, the proposed combination of Ward *et al.* and Rubini *et al.* fails to support a *prima facie* case of obviousness because it does not teach all the limitations of the claimed invention.

In view of the discussion above, Applicants submit that the pending claims are non-obvious and that the present rejection be withdrawn.

#### Objection to Claim 39

Claim 39 stands objected to as depending from a rejected base claim. Applicants submit that claim 1, from which claim 39 depends, is patentable. As such, Applicants request that that present objection to claim 39 be withdrawn.

#### Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **219002029100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: February 5, 2004

Respectfully submitted,

By 

James J. Mullen, III, Ph.D.

Registration No.: 44,957

MORRISON & FOERSTER LLP

3811 Valley Centre Drive, Suite 500

San Diego, California 92130

(858) 720-7940